

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** SHUNPEI YAMAZAKI

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Appeal No. 1996-0478  
Application No. 08/171,769

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HEARD: June 12, 2001

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Before HAIRSTON, NASE, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 20, 23, 24, 27, 30, and 31, which are all of the claims pending in this application.

We REVERSE.

## **BACKGROUND**

The appellant's invention relates to an insulated gate field effect transistor and its manufacturing method. The method includes the step of forming a gate insulating layer on a semiconductor layer and irradiating and doping the semiconductor layer through an opening in the gate insulating layer. An understanding of the invention can be derived from a reading of exemplary claim 20, which is reproduced below.

20. A method of forming a semiconductor device comprising the steps of:

forming a non-single crystalline semiconductor layer containing a recombination center neutralizer on an insulating surface of a substrate;

forming a gate electrode on said semiconductor layer with a gate insulating layer therebetween;

doping portions of said semiconductor layer with an impurity to form source and drain regions; and

exposing said portions to light irradiation in order to crystallize said portions or activate dopant impurities contained therein;

wherein said gate insulating layer extends beyond an edge of said gate electrode and covers said portions of the semiconductor layer, and the doping of said portions and the exposure of said portions to light irradiation are carried out through a part of said gate insulating layer located on said portions.

The reference of record relied upon by the examiner in rejecting the appealed claims is:

Yamazaki

4,727,044

Feb. 23, 1988  
(Filed May 20, 1985)

Claims 20, 23, 24, 27, 30, and 31 stand rejected under the judicially created doctrine of double patenting over claims 1-5 of U.S. Patent No. 4,727,044.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 22, mailed Jun. 21, 1995) for the examiner's reasoning in support of the rejection, and to the appellant's brief (Paper No. 21, filed May 18, 1995) and reply brief (Paper No. 25, filed Aug. 23, 1995) for the appellant's arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In support of the rejection, the examiner determined (answer, pp. 3-5) that the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, and there is no apparent reason why appellant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into the patent. In support of this type of rejection the examiner cited (answer, p. 5) **In re Schneller**, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

It appears to us that the examiner's rejection is based on an improper application of **Schneller**.<sup>1</sup> **Schneller** is a very special case of "obviousness-type" double patenting.<sup>2</sup> The United States Patent and Trademark Office has applied the term "non-obviousness-type" (as opposed to "obviousness-type") double patenting to the factual situation in **Schneller** in the past, MPEP § 804 (6th ed. Jan. 1995),

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<sup>1</sup> **Schneller** is a rather unusual case in that there was no majority opinion because only Judges Rich and Smith joined the principal opinion, while Judges Worley and Kirkpatrick concurred in the result and Judge Almond wrote a concurring opinion. Thus, the principal opinion therein is of doubtful controlling precedent. As Judge Rich observed in **In re Kaplan**, 789 F.2d 1574, 1578, 229 USPQ 678, 682 (Fed. Cir. 1986):

The development of the modern understanding of "double patenting" began in the Court of Customs and Patent Appeals (CCPA) about the time of **In re Zickendraht**, 319 F.2d 225, 138 USPQ 22 (CCPA 1963), a rather unusual case is [sic, in] that there was no majority opinion because only two judges joined each of the two principal opinions. Neither **opinion** therein, therefore, can be regarded as controlling precedent in this court.

<sup>2</sup> All types of double patenting which are not "same invention" double patenting have come to be referred to as "obviousness-type" double patenting. **See In re Van Ornum**, 686 F.2d 937, 942-43, 214 USPQ 761, 766 (CCPA 1982), which states in discussing cases leading to the restatement of the law of double patenting set forth in **In re Vogel**, 422 F.2d 438, 441-42, 164 USPQ 619, 621-22 (CCPA 1970):

numerous cases were considered in which application claims were directed to mere obvious modifications of, or improvements on, inventions defined in the claims of patents already issued to the same inventors, or to common assignees, and it had been decided that they might be allowed to go to patent if the applicants filed terminal disclaimers. We classified these as "obviousness type double patenting." This latter classification has, in the course of time, come, somewhat loosely, to indicate any "double patenting" situation other than one of the "same invention" type.

**See also General Foods Corp. v. Studiengesellschaft Kohl mbH**, 972 F.2d 1272, 1279-80, 23 USPQ2d 1839, 1844-45 (Fed. Cir. 1992).

pages 800-15, -16, but does not now use this label, MPEP § 804 (7th ed., Rev. 1, Feb. 2000), pages 800-21 through 800-23 (classifying double patenting as either "same invention" type or "non-statutory-" type where "non-statutory-type" could include a rejection which is not the usual "obviousness-type" double patenting). MPEP § 804 (7th ed., Rev. 1, Feb. 2000) now provides that "non-statutory-type" double patenting of the **Schneller**-type applies to those situations where: (1) the subject matter recited in the claims of the application is fully disclosed and **covered** by a claim in the patent (i.e., there has been no improvement or modification invented after filing and the application claim reads on subject matter which has been protected by a patent claim); and (2) there is no reason why the appellants were prevented from presenting the same claims for examination in the issued patent (i.e., there is no justification for extending the protection, such as the existence of a restriction requirement); and (3) no terminal disclaimer has been filed.

The condition of **Schneller** that the subject matter recited in the claims of the application is fully **covered** by a claim in the patent is not satisfied in this instance as clearly shown by the appellant's comparison of patent claims 1-5 and the claims under appeal (brief, pp. 10 and 11).

It is our view that insofar as **Schneller** is concerned, this case does not, as it appears the examiner would have us believe, stand for the proposition that simply because the subject matter recited in the claims on appeal was disclosed in the application from which the patent matured and the events which gave rise to the

situation were the result of the appellant's doing, the judicially created doctrine of double patenting would apply if the application claims were allowed to issue. The ruling in **Schneller** that double patenting existed was based upon a factual situation which is not present here, from which the court found the inventions not to be independent and distinct. It is our view that **Schneller** did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. In fact, the Court in **Schneller**, 397 F.2d at 355, 158 USPQ at 215, cautioned against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.

The Federal Circuit cites **Schneller** in **Eli Lilly Co v. Barr Laboratories, Inc.**, No. 99-1262, - 1263, -1264, -1303, Slip Opinion at 22-24, (Fed. Cir. May 30, 2001). **Eli Lilly** states:

Through a statutorily prescribed term, Congress limits the duration of a patentee's right to exclude others from practicing a claimed invention. 35 U.S.C. § 154(a)(2) (1994). The judicially-created doctrine of obviousness-type double patenting cements that legislative limitation by prohibiting a party from obtaining an extension of the right to exclude through claims in a later patent that are not patentably distinct from claims in a commonly owned earlier patent. **In re Longi**, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985) (explaining that, even though no explicit statutory basis exists for obviousness-type double patenting, the doctrine is necessary to prevent a patent term extension through claims in a second patent that are not patentably distinct from those in the first patent). As one of our predecessor courts explained, "[t]he fundamental reason for the rule [of obviousness-type double patenting] is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about." **In re Van Ornum**, 686 F.2d 937, 943-44, 214 USPQ 761, 766 (CCPA 1982) (quoting **In re Schneller**, 397 F.2d 350, 158 USPQ 210, 214 (CCPA 1968)).

Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claim in the earlier patent and the claim in the later patent and determines the differences. **Georgia-Pacific Corp. v. United States Gypsum Co.**, 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. **Id.** at 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting. **In re Berg**, 140 F.3d 1428, 1431, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998).

Here, appellant argues that the obvious-type (non-statutory) double patenting rejection required a comparison of the issued claims with the pending claims. (See brief at page 5.) We agree with appellant. Appellant argues that when a comparison of the claimed invention is made with the claims of the '044 patent, the pending claims are patentably distinct from those of the '044 patent. (See brief at page 9.) We agree with appellant. Appellant argues that each of the independent claims requires that the gate insulating layer extend beyond the edge of the gate electrode such that the exposure to light irradiation is carried out through the part of the gate insulating layer located outside the gate electrode. (See brief at page 9.) We note that the language of independent claims 24 and 27 does not specifically recite forming the gate insulating layer to extend beyond the gate electrode. When asked at the oral hearing, appellant's representative argued that the "wherein clause" of claims 24 and 27 clearly recites that the irradiation is carried out through a part of the gate insulating layer thereby clearly setting forth that the gate insulating layer extends beyond the gate electrode over the source and drain regions. We agree with appellant. At the oral

hearing appellant's representative further argued that in addition to the pending claims including the gate insulating layer extending beyond the gate electrode that the pending claims were independent and distinct from the patent claims since the patent claims included a further limitation concerning inverting the conductivity type of the source and drain using the gate electrode as a mask, which was not required by the present claims. We agree with appellant that the pending claims are independent and distinct from the patent claims. We note that the examiner merely concludes that double patenting exists and does not present any comparison of the pending claims with those of the patent. Moreover, from the evidence before us in this appeal, it appears to us that the patent claims and the application claims are directed to two separate inventions, and that the issuance of the application claims will not extend the



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exclusivity of the rights granted beyond the term of the patent. Therefore, we will not sustain the examiner's rejection of the claims 20, 23, 24, 27, 30, and 31 under the judicially created doctrine of double patenting.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 20, 23, 24, 27, 30, and 31 under the judicially created doctrine of double patenting over claims 1-5 of U.S. Patent No. 4,727, 044 is reversed.

REVERSED

KENNETH W. HAIRSTON  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

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